

REMARKS

Claims 1-10 have been cancelled. Claims 12-33 have been added. The claims present in this application are claims 10 through 33.

Claims 11 and 12 which are withdrawn from further consideration under 37 C.F.R. 1.142(b), are not being cancelled. These claims are being retained on record pending the filing of divisional applications directed thereto.

At the outset, applicant wishes to thank the examiner for the courtesies extended to him during the course of the recent telephone discussion. During this discussion, the rejections of claims under 35 U.S.C. 112 first and second paragraph were discussed.

In accordance with the aforementioned discussion, applicant is presenting claim 1 as three separate independent claims. These independent claims are Claims 13, 19, and 27. Originally claim 1 was directed compound of formula I which includes three separate products. These products are the compounds of formulae IV, V and VI. The process of claim 1 produces the product of claim IV, which is the compound of formula I where R¹ is hydrogen and Z is an amino protecting group. The process of claim 2 produces the compound of formula V, which is the compound of formula I where both R¹ and Z are amino protecting groups. On the other hand, the process of claim 3 produces the compound of formula VI which is the compound of formula 1 where R¹ is an amino protecting group and Z is hydrogen.

In this Amendment, applicants have presented claim 1 as three independent claims, claims 13, 19 and 26. Claim 13 is directed to preparing the compound of formula IV, from the compound of formula II. In this claim, all of the intermediates set forth in

the various steps of converting the compound of formula II to the compound of formula IV are set forth. Claim 19 is directed to preparing the compound of formula V from the compound of formula II and all other intermediates set forth in the preparation of the compound of formula V are set forth. Claim 26 is directed to preparing the compound of formula VI from the compound of formula II and all of the intermediates set forth in the conversion of the compound of formula II to the compound of formula VI are set forth. Since all of the claims 13 - 34 are directed to a process for preparing compounds of formula I which compound includes the compounds of claim 4 which is claim 13, the compound of formula V which is claim 19 and the compound of formula VI which is claim 26, claims 13 through 33 are directed to the elected group, Group I.

All of the claims 1-10 have been rejected under 35 U.S.C. first paragraph. This rejection as applied to claims 13 through 33 is respectfully traversed.

In view of the presentation of claims 1, 2 and 3 as independent, claims 13, 19 and 26, all of the intermediates necessary to prepare the claimed product in each of these separate claims are present in each of these claims. Therefore, these new claims, are not subject to a rejection under 35 U.S.C. 112 first paragraph. Applicants have complied with the request on page 7 of the outstanding Office Action so that all of the claims recite the individual process step including the intermediates formed in each step for producing the product of each of these claims. The final products of each of these claims are separate products produced by separate individual steps. The final product of claim 19 requires an additional step from that of claim 13 in order that this final product be produced. The final product of claim 26 is produced by two additional steps from the final product produced in claim 13 and one additional step from the final product

produced in claim 19. Since applicants have complied with all of the requirements set forth by the examiner, with respect to the 35 U.S.C. 112 first paragraph rejection, this rejection is overcome by the presentation of these new claims.

Claims 1 - 10 have been rejected under 35 U.S.C. 112 second paragraph. This rejection as applied to claims 13 through 34 is respectfully traversed.

One ground for this rejection is that the term “N-hydroxy group” is ambiguous and indefinite. In this respect, it is stated in the Office Action that it is not known whether the N-hydroxy group is the compound of formula II or III. In this respect, claims 13, 19 and 26 all refer to the N-hydroxy group being in the compound of formula III. In addition, compound of formula III is referred to in these claims as being N-hydroxy pyrrolidine derivative. Therefore, the N-hydroxy is specifically designated as being in the compound of formula III. In view of this, this term has been clarified in accordance with the suggestion on page 7 of the outstanding office action.

Another ground of this rejection is that limitation of N¹-amino group, used in claim 2, has no antecedent basis. Claim 2 has now been cancelled, and presented in claims 19 and 26, where the term N¹ -amino group, does not appear in the claim.

The claims recite that the compound of formula IV is reacted to protect the amino group in the compound of formula IV so as to produce said amino protected compound of formula V. In all cases, the N-amino group which is protected, is designated as the 3-N-amino group in the compound of formula IV. In view of this, and the removal of the limitation “N¹-amino group” it is submitted that the objection to this term has been obviated.

The objection that claims 2 and 3 recite a product which is ambiguous and indefinite has been obviated by the presentation of claims 19 and 26 which specifically state what compound is produced and designated the given compound that is produced.

In claim 19 the compound of formula V is produced. In claim 26, the compound of formula VI is produced. In addition, claim 19 is directed to the claim of the compound of formula V and the production of the compound and claim 26 is directed to production of the compound of formula VI. Therefore, it is clear what these final products. The intermediate of claim 4 is not converted into the compound of formula 1. This is clear because the compound of formula I contains 3 different compounds -- being the compound of formula IV, compound of formula V and the compound of formula VI. It is submitted that by reciting the formation of each of these individual compounds in 3 separate claims this rejection of the claims as being unclear as to how the intermediates are converted into formula I, has been obviated.

Based upon the foregoing, it is submitted that all of the rejections against the claims have been obviated and this application is in condition for allowance.

Correspondence and Fees

No fees are believed to be necessitated by the instant response. However, should this be in error, authorization is hereby given to charge Deposit Account No. 03-3839 for any underpayment, or to credit any overpayments.

Please address all correspondence to Intellectual Property Docket Administrator, Gibbons, Del Deo, Dolan, Griffinger & Vecchione, One Riverfront Plaza, Newark, NJ 07102-5497. Telephone calls should be made to William H. Epstein at (973) 596-4607 and fax communications should be sent directly to him at (973) 639-6397.

Respectfully submitted,



William H. Epstein
Registration No. 20,008
Attorney for Applicant

Gibbons, Del Deo, Dolan,
Griffinger & Vecchione
One Riverfront Plaza
Newark, NJ 07102-5497